IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.: 004770.00261
Martin Zilliacus	
Serial No.: 10/777,284	Group Art Unit: 2452
Filed: February 11, 2004	Examiner: DOAN, DUYEN MY
For: Apparatus and Associated Method for Downloading an Application With a Variable Lifetime to a Mobile Terminal	Confirmation No.: 5467

REPLY BRIEF

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Sir:

    This reply brief is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's answer mailed March 29, 2011. No oral hearing is requested in connection with this appeal. Accordingly, the briefs should be transmitted to the Board of Patent Appeals & Interferences for decision.

STATUS OF CLAIMS

Claims 1-22 and 50-52 have been canceled. Claims 23-49 and 53-103 are pending and stand rejected. Appellant hereby appeals the rejection of claims 23-49 and 53-103.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 23-26, 28 and 38-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold (U.S. Patent 5,940,504) in view of Ishida (U.S. Patent Application Publication No. 2002/0002042).

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida and further in view of McCormack et al. (U.S. Patent 6,360,255, hereinafter "McCormack").

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida and further in view of the examiner's Official Notice.

Claims 30-36 and 41-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida and further in view of Kim (U.S. Patent 6,546,002).

Claim 37 stands rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Kim and further in view of McCormack.

Claims 45-46, 48-49, 53-55, 57-59, 65-69, 73, 86-88, 90-92, 98-100, and 102-103 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida and further in view of Stefik (U.S. Patent 5,715,403).

Claims 47, 60-62, 71 and 93-95 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lin in view of Griswold and further in view of Forbes et al. (U.S. Patent 6,381,742, hereinafter "Forbes").

Claims 56 and 89 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Stefik and further in view of McCormack.

Claims 63-64, 70, 72, 96 and 97 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Stefik and further in view of Kim.

Claims 74-76, 78-79, 82, 85 and 101 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Stefik and further in view of Lin (U.S. Patent 6,366,791).

Claim 77 stands rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Stefik in view of Lin and further in view of McCormack.

Claims 80-81 and 83-84 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griswold in view of Ishida in view of Stefik in view of Lin and further in view of Kim.

Appellant appeals the rejection of all of the above-identified claims.

ARGUMENT

Pages 2-22 of the Examiner's answer raises no new issues beyond the arguments presented in the Office action mailed August 19, 2010. Appellant hereby maintains and incorporates by reference all arguments made in their appeal brief dated December 20, 2010. In addition, Appellant submits the following remarks in response to the Examiner's answer.

Part (10) of the Examiner's answer attempts to summarize pages 21-34 of Appellant's appeal brief as follows:

> **(10) Response to Argument**
>
> Appellant argues **A)**there are no reason to combine Griswold and Ishida
> because they are not analogous art. **B)** McCormack does not teach short-range
> connection and . **C)** Identifying the user based on Subscriber Identify Module (SIM) is
> not well known in the art. **D)** prior art Kim does not teach downloading the application a
> subsequent time if at least a portion of selected lifetime remain <u>and</u> the prior art does
> not teach claim 42, which the downloadable application is configured to delete itself
> when the selected lifetime expires. **E)** McCormack does not teach short-range
> connection. **F)** 1)Stefik does not mention an application can be disable, 2) Ishida does
> not teach "user selectable time period", 3) application configured to become unavailable
> by becoming non-functional, 4) prior art does not teach again receiving the application if
> the application has been used less than user-selected number of times. **G)** prior art
> does not teach 1)"delete an application with lifetime remaining in order to free storage
> space", 2) "delete a portion of itself", 3) "delete only the executable code", 4) "retain
> customized setting in the mobile terminal", 5) "delete a pre-existing application to create
> memory space for the first application".

Examiner's answer at page 22 (bold in original). On subsequent pages, the Examiner's answer provides further discussion as to each point.

With respect to A), the Examiner's answer lumps together two distinct arguments by Appellant. The first of the lumped-together arguments is that no proper reason has been shown

for combining Griswold and Ishida in the non-final rejection. (Appeal brief, page 22.) The second of the lumped-together arguments is that neither Griswold nor Ishida teaches features of, for example, claim 23. (Appeal brief, pages 22-23.) Appellant notes that the Examiner's answer does not appear to even respond to either of the above noted arguments. Instead, the Examiner's answer states the following:

> **In response to A)** Griswold discloses the concept of transmitting and managing license product such as software, music, video, etc in a telecommunication network. Ishida teaches allowing the user to set the valid time period for the data in a telecommunication network. Both of Griswold and Ishida concern with data communication in general in a telecommunication network, therefore they're analogous art. One ordinary skill in the art would come up with the claimed invention using Griswold's concept of transmitting and managing license product and the user setting the valid time period of the data in Ishida for the obvious purpose of allowing the user control over license product that he/she is purchasing.

(Examiner's answer, page 23.) These statements are not a response to Appellant's arguments that no proper reason has been shown for combining Griswold and Ishida in the asserted manner, and that neither Griswold nor Ishida teaches features of claim 23.

With respect to B), the Examiner's answer again lumps together two distinct arguments by Appellant. The first of the lumped-together arguments is that no proper reason has been shown for combining Griswold, Ishida and McCormack in the non-final rejection. (Appeal brief, page 23.) The second of the lumped-together arguments is that the combination of Griswold, Ishida, and McCormack fails to teach all features of claim 27. (Appeal brief, pages 23-24.) Appellant notes that the Examiner's answer does not appear to address the first argument (that no proper reason has been shown for combining Griswold, Ishida and McCormack). With respect to the second argument, the Examiner's answer states the following:

In response to B) McCormack teaches in col.2, lines 66-67 downloading the

software components to the network devices and in col.15, line 55, discloses the

infrared data communication network (Examiner Note: it is well known to one with

ordinary skill in the art that infrared data communication network is a short-range

connection). One ordinary skill in the art with the teachings in col.2 and col.15 above

would realize that it is possible to download the software components over an infrared

data communication network which is a short range communication in itself.

(Examiner's answer, page 24.) Despite maintaining the rejection of claim 27 under a combination of Griswold, Ishida and McCormack on pages 6-7 of the Examiner's answer, the Examiner now appears to be taking Official Notice as to claim 27 that an infrared data communication network is a short-range connection. McCormack does not teach or suggest an infrared data communication *network*, as alleged by the Examiner. In particular, McCormack merely mentions infrared data connections at col. 15, line 55. The paragraph containing col. 15, line 55 is reproduced below:

> The term "computer-readable medium" as used herein refers to any medium that participates in providing instructions to processor **704** for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and transmission media. Non-volatile media includes, for example, optical or magnetic disks, such as storage device **710**. Volatile media includes dynamic memory, such as main memory **706**. Transmission media includes coaxial cables, copper wire and fiber optics, including the wires that comprise bus **702**. Transmission media can also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications.

McCormack, col. 15, ll. 43-55. Nowhere in McCormack is there a teaching or suggestion that "infrared data communications," as described in McCormack, is an infrared data communication *network*, as construed by the Examiner in the Examiner's answer. As seen above, McCormack merely describes infrared data communications as generating "acoustic or light waves" which is

a form transmission media that "participates in providing instructions" to a processor for execution. McCormack, col. 15, ll. 43-55. This is not a teaching or suggestion the short-range connection, on which the step of downloading over the wireless connection is achieved, is "an infrared connection," as recited in clam 27.

With respect to C), the Examiner's answer again lumps together two distinct arguments by Appellant. The first of the lumped-together arguments is that no proper reason has been shown for combining Griswold, Ishida and Official Notice in the non-final rejection. (Appeal brief, page 24.) The second of the lumped-together arguments is that neither Griswold nor Ishida nor McCormack teaches features of claim 27. (Appeal brief, pages 24-25.) Appellant notes that the Examiner's answer does not appear to address the first argument (that no proper reason has been shown for combining Griswold, Ishida and Official Notice).

With respect to D), the Examiner's answer appears to merge Appellant's arguments as to at least claims 30 and 42. (Examiner's answer, page 24.) With respect to claim 30, the Examiner's answer appears to maintain its position that Kim allegedly describes downloading the application a subsequent time if at least a portion of the selected lifetime remains. Specifically, the Examiner's answer states that "one [of] ordinary skill in the art would [have] realized that in order for the system in Kim to work, it is necessary for the server to check the license term (the number of uses or the time period) before allow [sic] the user to reinstall (i.e., access the licence product for the subsequent time)." (Examiner's answer, page 24.) Even assuming, without admitting, the truth of the Examiner's statement, this interpretation of Kim still does not teach or suggest downloading the application a subsequent time if at least a portion of the selected lifetime remains. As discussed in Appellant's appeal brief at page 25, re-installation (and/or accessing the licensed product a subsequent time) is conceptually separate from re-downloading, and does not teach or suggest re-downloading the product a second time if the license term has not yet expired.

With respect to claim 42, the Examiner's answer appears to maintain its position that Ishida allegedly describes that a "downloadable application is configured to delete itself from the at least one mobile terminal when the selected lifetime expires," as recited in claim 42. As discussed in Appellant's appeal brief at page 25, Appellant has carefully studied Ishida but can find no such feature. Paragraph [0029] of Ishida does mention that a code can be designated as

"erasure" and that message data is erased "if protection designation data as data for designating protection is not stored in correspondence with the message data," but there is simply no suggestion – nor is it inherent – that the message in Ishida is configured to delete itself when then the selected lifetime expires. Paragraph [0030] of Ishida does mention that a message may include a time period where the message data is not erased, but there is simply no suggestion – nor is it inherent – that the message in Ishida is configured to delete itself when then the selected lifetime expires.

With respect to E), section E) of the Examiner's answer is substantially similar to section B). (*Compare* Examiner's Answer, page 23 *and* Examiner's Answer, pages, 24-25.) As discussed above with respect to section B), the Examiner now appears to be taking Official Notice that an infrared data communication network is a short-range connection. Indeed, nowhere in McCormack is there a teaching or suggestion that "infrared data communications," as described in McCormack is an infrared data communication *network*, as construed by the Examiner in the Examiner's answer. McCormack merely describes infrared data communications as generating "acoustic or light waves" which is a form transmission media that "participates in providing instructions" to a processor for execution. McCormack, col. 15, ll. 43-55.

With respect to F), the Examiner's answer breaks section F) into four subsections. With respect to the first subsection identified as F-1), the Examiner's answer again lumps together two distinct arguments by Appellant. The first of the lumped-together arguments is that no proper reason has been shown for combining Griswold, Ishida and Stefik in the non-final rejection. (Appeal brief, page 27.) The second of the lumped-together arguments is that neither Griswold nor Ishida nor McCormack teaches features of claim 45. (Appeal brief, pages 28.) Appellant notes that the Examiner's answer does not appear to address the first argument (that no proper reason has been shown for combining Griswold, Ishida and Official Notice). With respect to the second argument, the Examiner's answer appears to maintain that Stefik allegedly describes "an application disabler coupled with the CPU and configured to disable an application." (Appeal brief, page 27.) As discussed in the appeal brief, Stefik fails to describe such a feature. (*Id.*) Col. 2, ll. 1-6 of Stefik does mention an application can be disabled, but there is simply no suggestion – nor is it inherent – that "an application disabler coupled with the CPU and

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configured to disable an application" is performing the disabling of Stefik. Accordingly, the rejection of this claim is traversed.

With respect to the second subsection identified as F-2, the Examiner's answer maintains that Ishida allegedly describes "a user-selectable time period," as recited in claim 86. (Examiner's Answer, page 25.) As explained in the appeal brief, Ishida merely discloses erasing message data from a calling apparatus after an expiration of a period preset by a user. Ishida, paragraph [0005]. Even assuming, without admitting, that the "period preset by a user," as described in Ishida, is equivalent to "a time period," merely erasing message data upon expiration of a period present by a user does not teach or suggest that the first application is "configured to become unavailable for use on the apparatus upon...expiration of a user-selectable time period," as recited in claim 86. In other words, the message data itself is not "configured" as recited in claim 86.

With respect to the third subsection identified as F-3), the Examiner's answer maintains that Stefik allegedly describes an application "configured to become unavailable by becoming non-functional," as recited in claims 59 and 92. (Examiner's answer, page 25.) As discussed in the appeal brief, while Stefik does mention (e.g., at col. 2, ll. 1-6) that applications can be disabled, merely disabling an application does not teach or suggest an application is itself "configured to become unavailable by becoming non-functional," as recited in claims 59 and 92. The digital works in Stefik are not configured to become non-functional – the "usage rights" for the digital works are enforced by another entity (e.g., the repositories). *See, e.g.,* Stefik, col. 4, lines 25-39. In other words, the digital works themselves are not "configured" to do anything.

With respect to the fourth subsection identified as F-4), the Examiner's answer maintains that Kim allegedly describes "again receiving the first application if the first application has been used less than the predetermined number of times," as recited in claim 63. As discussed above in connection with section D) of the Examiner's answer and in the Appeal Brief at pages 32 and 33, Kim merely discloses allowing a re-installation of a product. *See, e.g.,* Kim, col. 3, lines 31-47. Re-installation (and/or accessing the licensed product a subsequent time) is conceptually separate from re-downloading, and does not teach or suggest "again receiving the first application if the first application has been used less than the predetermined number of times," as recited in claim 63.

With respect to G), the Examiner's answer breaks section G) into five subsections. With respect to the first subsection identified as G-1), the Examiner's answer maintains that Forbes allegedly describes that the application disabler is "configured to delete an application with lifetime remaining in order to free storage space in the memory unit," as recited in claim 47. As discussed in the Appeal Brief at page 30, Forbes merely describes that a "package manager" can "delete the package entries from the installed package database...when the packages have been deleted from the FSC directory." Forbes, col. 8, ll. 14-17. Merely deleting package entries, as in Forbes, does not teach or suggest an application disabler that is "configured to delete an application with lifetime remaining in order to free storage space in the memory unit," as recited in claim 47. Additionally, even assuming, without admitting, that the "package manager" of Forbes is an "application disabler" as recited in claim 47, Forbes simply does not teach or suggest that its "package manager" is configured to "delete an application with lifetime remaining in order to free storage space in the memory unit," as recited in claim 47. Indeed, the Examiner's answer admits that "Forbes [is] not concerned with the lifetime of the application." (Examiner's Answer, page 26.) Thus, because Forbes is not concerned with the lifetime of the application, it follows that the "package manager" is not configured to "delete an application with lifetime remaining in order to free storage space in the memory unit," as recited in claim 47.

With respect to the second subsection identified as G-2), the Examiner's answer appears to maintain that the combination of Griswold-Ishida-Stefik-Forbes allegedly describes that the application "is configured to become unavailable by automatically deleting a portion of itself," as recited in claims 60 and 93. (Examiner's answer, page 26.) Specifically, the Examiner's answer states that "[w]hen the software is deleted, it [is] deleting the portion of itself." (*Id.*) Thus, it appears that the Examiner is taking the position that merely deleting software is equivalent to an application being "configured to...automatically [delete] a portion of itself," as recited by claims 60 and 93. Appellant disagrees. As discussed in the appeal brief on pages 30 and 31, Forbes fails to teach or suggest an application <u>configured to</u> delete a portion of itself. In Forbes, another entity performs the deletion (e.g., the package manager). *See, e.g.,* Forbes, col. 8, ll. 14-17. Additionally, Forbes does not teach or suggest that any entity (either the package, the package manager, etc.) is configured to <u>automatically</u> delete a portion of itself.

With respect to the third subsection identified as G-3, the Examiner's answer appears to maintain that the combination of Griswold-Ishida-Stefik-Forbes allegedly describes that the application is "configured to delete only executable code," as recited in claims 61 and 94. (Examiner's answer, page 26.) Specifically, the Examiner's answer states that "[w]hen the software is deleted, it [is] deleting the portion of itself and since the software includes the executable code, the executable code will be deleted." (*Id.*) Thus, it appears that the Examiner is taking the position that merely deleting software is equivalent to an application being "configured to delete only executable code," as recited by claims 60 and 93. Appellant disagrees. As discussed in the appeal brief on page 31, Forbes fails to teach or suggest that the application is <u>configured to</u> delete only executable code. In Forbes, another entity performs the deletion (e.g., the package manager). *See, e.g.,* Forbes, col. 8, ll. 14-17. Additionally, Forbes does not teach or suggest that any entity (either the package, the package manager, etc.) is configured to delete <u>only</u> executable code.

With respect to the fourth subsection identified as G-4, the Examiner's answer appears to maintain that Forbes allegedly describes that the application "is configured to retain customized settings in the mobile terminal," as recited in claims 62 and 95. In particular, the Examiner's answer states that "[o]ne [of] ordinary skill in the art would understand that the user's pre-set period will not be erased (i.e. retain user's setting) but only the data will be erased." (Examiner's answer, page 27.) Even assuming, without admitting, the truth of the Examiner's statement, this statement says nothing about the application being "configured to retain customized settings in the mobile terminal," as recited in claims 62 and 95. Merely retaining user's settings does not teach or suggest an application "configured to retain customized settings in the mobile terminal," as claimed.

With respect to the fifth subsection identified as G-5, the Examiner's answer appears to main maintain that the combination of Griswold-Ishida-Stefik-Forbes allegedly describes "deleting a pre-existing application to create memory space for the first application," as recited in claim 71. In particular, the Examiner's answer states that "Griswold-Ishida-[Stefik]-Forbes teaches deleting the software if it is no longer needed (examiner note: the software which [is] no longer needed is the pre-existing application) (see Forbes col. 8, lines 7-17)." (Examiner's answer, page 27.) Even assuming, without admitting, the truth of the Examiner's statement,

merely deleting software if it is no longer needed fails to teach or suggest "deleting a pre-existing application to create memory space for the first application," as recited in claim 71. Put simply, merely deleting software if it is no longer needed is not the same as deleting an application to create memory for another application.

For the reasons set forth above and in their appeal brief dated December 20, 2010, Appellant submits that the rejections of the office action mailed August 19, 2010, are not proper. Appellant respectfully requests that the Board reverse the Examiner's rejection.

CONCLUSION

For all the foregoing reasons, and based on the previously submitted arguments, Appellant respectfully requests that the Board instruct the withdrawal of the rejections and pass this case to issuance at its earliest convenience. If there are any questions or any additional information is required, please contact Appellant's undersigned representative at (202) 824-3317.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: May 27, 2011

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